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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,989	09/25/2003	Michael Wisniewski	PROS1130	4517
44654 7590 10/09/2009 SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705				
EXAMINER FEENEY, BRETT A				
ART UNIT 3624		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/670,989

**Applicant(s)**

WISNIEWSKI ET AL.

**Examiner**

BRETT FEENEY

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/02/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6, 7, 12, 17, 23, 24 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 12, 23, 24 and 34-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of the Claims**

1. The following **FINAL** Office Action is in response to Applicant's submission received on 09/01/2009.
2. Claims 1, 6, 7, 17, 23, 24, 34-39 were amended. No claims were added or canceled.
3. Claims 1 – 3, 6 – 7, 12, 17, 23, 24 and 34 – 43 are pending and have been examined.

### **Response to Amendment**

4. Applicant's amendments to the claims are herein acknowledged. As a result of the amendments the Examiner has withdrawn the previous rejections under § 112 and § 103. Further, the Examiner has entered new rejections under 35 USC § 112, § 101 and § 103.

### **Response to Arguments**

5. Applicant's arguments received on April 15, 2009 have been fully considered but they are moot in view of the new grounds of rejection. Applicant's arguments are generally directed towards newly presented claim limitations in respect to art applied in the previous rejection. However, in the instant office action, the newly

presented claim limitations are rejected under § 103 as being obvious in view of newly cited art, Herz in combination with previous cited art Choi/Holloway.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 – 3, 6 – 7, and 34 – 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claim 1 appears to be directed towards a hybrid claim, wherein the claim mixes statutory classes between a method and a system (however, it does not appear to be a product by process claim). Therefore, the claim is vague and indefinite. Appropriate correction is required. Claims depending from claim 1 are rejected for similar reasons.
  - Claim 34 recites “to determine an offer having a selected order to maximize profit”. However, it is not clear how “an offer” can have a selected order. Therefore, the claim is vague and indefinite. The Examiner has interpreted this limitation to mean that the offer is profit maximizing.

***Rejections under § U.S.C. 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 – 3, 6 – 7, and 34 – 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
10. Claims 1 – 3, 6 – 7, and 34 – 37 are directed to a method. However, the recited steps of the method are held to be non-statutory subject matter because the recited steps of the method are (1) not tied to another statutory class or (2) not transforming the underlying subject matter to a different state or thing.

#### **Rejections under § U.S.C. 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 – 3, 6 – 7, 12, 17, 23, 24 and 34 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi et al. US 6,895,405 (hereinafter Choi), in view of Holloway et al., US 2003/0033193 (hereinafter Holloway); further in view of Herz et al., US 2001/0014868 (hereinafter Herz).

### Claim 1

Choi discloses a computer-implemented method for the optimization of a process comprising:

- *providing a system* (see at least FIG 9 and associated text in column 29, lines 9-53; Noting Choi teaches a computer that contains a storage medium, processor, database, instructions, interfaces and the like.);
- *receiving information about a customer* (see at least FIG 11 and associated text in column 2, lines 47-67; Noting, customer information is received via a survey. Further, noting the information from the surveys may be received from another party (i.e. double blinded studies conducted) or "indicat[ed] that a survey variable was important" (i.e. directly from the customer).);
- *wherein the information comprises receiving information directly entered by the customer* (see column 7, lines 11-10; noting individuals taking survey provide information whether they agree or disagree with a statement);
- *matching the information about the customer to a profile stored in the customer profile database based on the customer information* (Id. Noting, that the process of segmentation is matching customer responses with others that respond[ed] the same. Each cluster is a profile for a group of respondents (customers).);
- *storing the response in the database* (see at least FIG 9 and associated text in column 29, lines 9-53; Noting, Choi teaches saving responses based on every methodology disclosed in databases.);

- *determining a distribution of customer responses* (see at least column 5, lines 8-16; Noting "...distributions of about 25% agree/important, 50% neutral/no opinion, 25% disagree/unimportant.");

Choi teaches clustering similar respondents for the purpose of targeted marketing. Choi does not explicitly teach a method for interactive marketing *per se*, however Holloway teaches:

- *repeating the selecting, presenting, receiving and storing steps for each customer of a plurality of customers* (see at least paragraph 0010; "...the programming instructions include instructions for causing the client to parse the data elements from the survey document into data arrays. The data arrays include cross-references defining associations among questions and answers. The arrays provide an efficient data structure by which the applet can follow a chain of cross references and compile, for adding to the survey, branches of sub-questions for particular answers received from a user.");

Choi/Holloway teaches gathering and analyzing customer data for improved customer marketing. Choi/Holloway does not explicitly recite presenting offers associated with a profile derived from the customer data, however in analogous art Herz teaches:

- *selecting an offer from a set of offers associated with the profile, wherein each offer in the set of offers is unique, wherein the set of offers comprises a plurality of alternative offers associated with the customer need and a business context* (see FIG 1 and associated text; noting "Shopper Profile Data"; Shopper Data

Base", "Offer Data Base", etc. Further, see ¶ 0002; noting "[t]he system automatically constructs and updates profiles of a plurality of shoppers based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information.").

- *presenting the offer to the customer of the plurality of customers associated with the profile* (*Id.* Further see ¶ 0003; noting [o]n-line shopping allows further customization, down to the level of the single individual based on "click streams" (the sequence of keys pressed on a computer) or purchase histories of that individual.");
- *receiving a response to the offer from the customer* (*Id.* Noting, "based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information.").
- *analyzing the distribution of responses to all actions of the set of offers presented to the customers associated with the profile* (see ¶ 0005; noting "tracking can comprise a number of sources of data to thereby utilize multiple attribute clustering to provide a more powerful analysis capability" (noting clustering is as method for analyzing a distribution of responses)) *wherein the analysis identifies one offer of the set of offers that best fits the customer need and the business context for a given profile* (*Id.* Further noting, "[t]he system can then select, present, price, and promote goods and services in ways that are tailored to an individual consumer.");



- *updating the set of offers in the database based on the analysis of the distribution of responses, wherein future offers presented to customers associated with the profile are selected by the action selection module from the updated database* (see see ¶¶ 0005-0007; noting [o]ffers can be profiled as well. Possible attributes for offers include the newness and advertised duration of the offer, the type of product or service being offered, the product's brand name and features, the shoppers who tend to buy the product, other products frequently bought on the same shopping trip, the sales pitch, the price and terms of payment, any discounts provided, and the relative attributes of competing offers. The system of U.S. Pat. No. 5,758,257 describes several techniques that can be used for exploiting these profiles of shoppers (called "users" there) and offers (called "target objects" there)".).

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi with the method of interactive marketing taught by Holloway and the step of presenting offers associated with a profile derived from the customer data taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

## **Claim 2**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein matching the information about the customer to a profile further comprises collecting historical information* (see at least column 5, lines 35-60; Noting the various data collected on customers pertaining to their responses. Further, see at least column 31, lines 8-19; Noting, "historical data").

### **Claim 3**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *receiving information about a customer further comprises augmenting the information with information received from external sources* (see at least column 3, lines 1-16, noting survey questions are asked of individuals, who are external sources to the marketing firm. Further, see at least FIG 3 and associated text in column 23, lines 25-37; Noting initial data is appended based on observational information.).

### **Claim 6**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Herz teaches:

- *wherein the set of offers is specific to the profile, wherein each offer in the set of offers is selected based on a response forecast, and wherein a response to the offer presented to the customer is used to update the set of action contained in the response forecast* (*Id.* at **Claim 1**. Noting offers are profiled and may be tailored to the specific user or any designated level of granularity. Further noting

in ¶0007; “[p]redicting the probability that a given shopper will accept a particular offer.).

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi/Holloway/Herz with the step of selecting which offer to present based on a response forecast taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

#### **Claim 7**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Herz teaches:

- *wherein the action database contains a history of responses for each offer, wherein the action selection module analyzes the history of responses associated with the profile in selecting an offer from the set of offers (Id. Noting, offers are profiled including historical data that includes how customers responded to offers at a given time, with given terms, discounts and the like.);*

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi/Holloway/Herz with the step of selecting which offer to present based on a response history taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 12-15, 17, 23, 24, 28 and 29** recite limitations addressed in the claims above and are therefore rejected for similar reasons.

**Claim 34**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the distribution of responses is analyzed to determine an offer having a selected order to maximize profit (Id. at **Claim 1**. Further, see at least column 19, lines 43-49; Noting Choi explicitly teaches practicing the disclosed method to maximize profit.).*

**Claim 35**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the distribution of responses is analyzed (Id. at **Claim 1**. Further, see at least column 19, lines 1-9; Noting Choi explicitly practicing the disclosed method to maximize revenue.).*

**Claim 36**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- The Examiner notes that the limitation disclosed in the claim is directed to non-functional descriptive material. However, Choi explicitly teaches presenting

"price-attribute-bundle[s]" to customers to determine the customer's need and willingness to pay for product features. Further, Choi performs this method in context of the method described in the claims above in order to maximize profit and revenue (*Id.* at **Claim 1, Claim 34 and Claim 35**).

**Claim 37**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the offer presented to a customer is selected from the set of offers based on the price, wherein the price is below the customer's willingness to pay (Id. Further, see at least column 8, lines 1-14; Noting, Choi teaches econometric customer profiling based on a plurality of data including product price and customer's willingness to pay (i.e. purchase) a product given a set of alternatives.).*

**Claims 38 - 43 recite limitations addressed in the claims above and are therefore rejected for similar reasons.**

### **Conclusion**

The following references are considered relevant to the instant application, however they were not applied as prior art in the instant office action:

- Ananian, US 2003/0028451; discloses an interactive digital catalog of products, service and information that is responsive to personalized and/or profiled content.
- Sridar et al., US 2003/0208754; discloses a system and method for predictively profiling customers based on customer behaviors, historical transactions and similarly profiled customers, etc. and dynamically presenting content to the customers based on the profiled information.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Brett Feeney** whose telephone number is **571.270.5484**. The Examiner can normally be reached on Monday-Thursday, 7:30am-6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BRAD BAYAT** can be reached at **571.272.6704**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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